

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RAJIV V. JOSHI  
and MANU J. TEJWANI

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Appeal No. 1998-1095  
Application No. 08/367,565

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ON BRIEF

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Before HAIRSTON, BARRETT, and BLANKENSHIP, Administrative  
Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3, 5 through 14, 16 through 20, 39 and 40.

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The disclosed invention relates to a soft metal conductor. The soft metal in the soft metal conductor is selected from the group consisting of Al, Cu and Ag.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A soft metal conductor comprising an upper-most layer consisting of grains capable of providing a substantially scratch-free planar surface upon polishing in a subsequent chemical mechanical polishing step, said soft metal is selected from the group consisting of Al, Cu, Ag, binary and ternary alloys of Al, Cu and Ag.

The reference relied on by the examiner is:

Kikkawa	5,345,108	Sept. 6,
1994		

Claims 1 through 3, 5 through 14, 16 through 20, 39 and 40 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Kikkawa.

Reference is made to the final rejection, the brief and the answer for the respective positions of the appellants and the examiner.

#### OPINION

The 35 U.S.C. § 102(a) rejection of claims 1 through 3, 5 through 14, 16 through 20, 39 and 40 is reversed.

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According to the examiner (Final rejection, page 2), Kikkawa discloses a first soft metal layer 105 of AlSiCu, and a second soft metal layer 107 of AlSiCu. The examiner further states (Final rejection, page 3) that the "process limitations cannot impart patentability to product claims where the product is not patentably distinguished over prior art."

Appellants argue (Brief, page 5) that "the present application does not contain any product by process claims." We agree. The phrase "capable of providing a substantially scratch-free planar surface upon polishing in a subsequent chemical mechanical polishing step" is a statement of intended use of the soft metal conductor, and it is not a process step for making the soft metal conductor per se.

Appellants also argue (Brief, page 6) that:

The present invention teaches a soft metal selected from the group consisting of Al, Cu, Ag, binary and ternary alloys of Al, Cu and Ag. This is equivalent to reciting a soft metal selected from the group consisting of Al, Cu, Ag, AlCu, AgCu, AlAg and AlCuAg. On the other hand, the Kikkawa reference teaches an alloy of AlCuSi wherein Si is not a component presented in any one of the compositions claimed by the Appellant[s]. Moreover, at no place in the Kikkawa patent has [Kikkawa] mentioned that his alloy is a soft metal that is scratch resistant. Furthermore, Kikkawa has not taught, disclosed or suggested the grain size of the alloy particles.

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We agree with appellants' arguments. The phrase "consisting of"<sup>1</sup> in the claims limits each of the claims to the elements recited therein. Thus, the claims on appeal are not anticipated by the teachings of Kikkawa because of the presence of Si in the alloy AlSiCu.

DECISION

The decision of the examiner rejecting claims 1 through 3, 5 through 14, 16 through 20, 39 and 40 under 35 U.S.C. § 102(a) is reversed.

REVERSED

	Kenneth W. Hairston	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Lee E. Barrett	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	

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<sup>1</sup> In Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc., 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986), the Court noted that "the phrase 'consisting of' appears in clause (a), not the preamble of the claim, and thus limits only the element set forth in clause (a)."

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Howard B. Blankenship )  
Administrative Patent Judge )

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